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REMARKS

In the non-final Office Action of November 13, 2003, the Examiner rejected claims 14, 23, and 25 under 35 U.S.C. § 112, second paragraph; rejected claims 6-11, 15-20, and 24-25 under 35 U.S.C. § 102(e) in view of U.S. Patent No. 5,754,938 to Herz et al. ("Herz") and rejected claims 12-14 and 21-23 under 35 U.S.C. § 103(a) in view of Herz.

By this Amendment, Applicants have amended claims 6, 15, 24, and 25 for clarity. In view of the Amendments, Applicants submit the rejections of claims 14, 23, and 25 under 35 U.S.C. § 112, second paragraph, are obviated.

For the following reasons, Applicants respectfully traverse the rejection of claims 6-11, 15-20, and 24-25 under 35 U.S.C. § 102(e).

The present invention, as recited, for example, in amended claim 6, is significantly different from the disclosure of Herz. The invention of claim 6 is directed to a method executed in a computer system for targeting advertisements. The method includes defining at least one category as containing documents that may be retrieved and associating at least one supercategory with multiple categories by mapping the multiple categories to the at least one supercategory. The method further includes associating an advertisement with at least one of the supercategories, the advertisement being separate from the documents contained in the at least one category, determining at least one term associated with a user search query, and determining a first of the at least one supercategory based on at least one term of the user search query and the multiple categories of the at least one supercategory. The method

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further includes displaying an advertisement associated with the first supercategory.

The disclosure of Herz relates to customized electronic identification of desirable objects, such as news articles, in an electronic media environment. (Herz, col. 1, lines 16-18). Herz discloses constructing a "target profile" for the objects and a "target profile interest summary" for each user. (Herz, col. 1, lines 19-24). The system of Herz then "evaluates the target profiles against the users' target profile interest summaries to generate a user-customized rank ordered listing of target objects most likely to be of interest to each user." (Herz, col. 1, lines 26-29). The system of Herz is said to enable "a user to access target objects of relevance and interest to the user without requiring the user to expend an excessive amount of time and energy." (Herz, col. 4, lines 38-41).

In rejecting claim 6, the Examiner appears to contend that Herz's disclosure that the target objects can be "products sold through promotional channels," reads on associating an advertisement with at least one supercategory, as recited in claim 6. (Office Action, page 3, citing col. 9, lines 12-13 of Herz). Additionally, regarding the categories and supercategories recited in claim 6, the Examiner appears to contend that Herz's disclosure relating to creating hierarchical clusters of target objects reads on the categories and supercategories recited in claim 6. (Office Action, page 4, citing col. 7, lines 50-51, col. 8, lines 48-49 and 58-59, and col. 63, line 63 of Herz).

Applicants respectfully disagree with the Examiner's characterization of Herz. Although Herz may disclose clusters of target objects and a hierarchical

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arrangement of the target objects, Herz does not additionally associate advertisements with the clusters, in which the advertisement is separate from the target objects that define the cluster. Specifically, Herz does not disclose, as recited in claim 6, "defining at least one category as containing documents that may be retrieved" and "associating an advertisement with at least one supercategory, the advertisement being separate from the documents contained in the at least one category." Thus, although Herz discloses that the target objects may include "products being sold" and defines clusters containing target objects, Herz does not additionally associate a target object with a cluster, in which the associated target object is separate from the target objects in the cluster.

Claim 6, in contrast to Herz, recites, among other things, "defining at least one category as containing documents that may be retrieved; associating at least one supercategory with multiple categories by mapping the multiple categories to the at least one supercategory; [and] associating an advertisement with at least one of said supercategories, the advertisement being separate from the documents contained in the at least one category." As discussed in the previous paragraph, Herz may be said to create clusters of target objects, but Herz completely fails to disclose or suggest an additional association of an advertisement with a cluster.

Claim 6 additionally recites "determining at least one term associated with a user search query; determining a first of said at least one supercategory based on at least one term of said user search query and said multiple categories of the

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at least one supercategory; and displaying an advertisement associated with said first supercategory." Herz, at column 64 and column 66, lines 38-67, discloses techniques that a user may use to navigate through target objects in a hierarchical tree of target objects. Thus, Herz appears to disclose allowing users to browse target objects based on the target object clusters. Herz, however, completely fails to disclose or suggest displaying an advertisement associated with a first supercategory, as recited in claim 6.

For at least these reasons, Applicants submit that Herz fails to disclose or suggest many of the features recited in amended claim 6. Accordingly, the rejection of claim 6 based on Herz is improper and should be withdrawn. At least by virtue of their dependency on claim 6, the rejection of claims 7-11 should also be withdrawn.

Claims 7-11 recite additional features that are not disclosed or suggested by Herz. Claim 7, for example, recites that there is more than one supercategory and further recites ranking the more than one supercategory to determine the first supercategory. The Examiner points to Fig. 7 and column 24, lines 12-45 of Herz as disclosing the features of claim 7. (Office Action, page 3). Applicants submit that this section of Herz describes the hierarchical clustering of Herz, but in no way discloses or suggests ranking more than one supercategory to determine the first supercategory, as recited in claim 7. Accordingly, for this reason also, the rejection of claim 7 should be withdrawn.

Claim 9 also depends from claim 6 and recites that the documents include business listing information. The Examiner points to column 9, lines 15-17 of

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Herz as disclosing this feature of the invention. (Office Action, page 4). This section of Herz discloses "the user is an investor and the target objects are publicly traded stocks, mutual funds and/or real estate properties." This disclosure of Herz in no way discloses or suggests documents that include business listing information. Accordingly, for this reason also, the rejection of claim 9 should be withdrawn.

Independent claim 15, as amended, recites a number of features similar to those recited in claim 6. Accordingly, based on rationale similar to that given above, Applicants submit that the rejection of claim 15 under 35 U.S.C. § 102(e) is improper and should be withdrawn. The rejections of claims 16-20, at least by virtue of their dependency from claim 15, are also improper and should be withdrawn.

Claims 16-20 recite additional features that are not disclosed or suggested by Herz. Claim 16, for instance, recites features similar to claim 7 and claim 18 recites features similar to claim 9. Thus, for the reasons given above similar to those given for claims 7 and 9, Applicants submit that the rejections of claims 16 and 18 are additionally improper and should be withdrawn.

Independent claim 24, as amended, recites a number of features similar to those recited in claim 6. Accordingly, based on rationale similar to that given above, Applicants submit that the rejection of claim 24 under 35 U.S.C. § 102(e) is improper and should be withdrawn. The rejection of claim 25, at least by virtue of its dependency from claim 24, is also improper and should be withdrawn.

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Claim 25 recites additional features that are not disclosed or suggested by Herz. Claim 25, for instance, recites features similar to claims 7 and 16. Thus, for reasons similar to those given for claims 7 and 16, Applicants submit that the rejection of claim 25 is additionally improper and should be withdrawn.

Dependent claims 12-14 and 21-23 stand rejected under 35 U.S.C. § 103(a) based on Herz. Applicants respectfully traverse this rejection. These claims are patentable over Herz, at least because these claims are dependent claims from claims 6 and 15, as well as for reasons of their own.

Claim 12, for example, further defines the method of claim 6, and recites that determining a first of at least one supercategory includes determining a geographic area that is a search term included in the user search query. The Examiner concedes that Herz does not disclose determining a geographic area that is a search term, but asserts that this feature of claim 12 would have been obvious to one of ordinary skill in the art because "many of the example target objects entail geography". (Office Action, page 4). Applicants submit that just because a target object can in some tangential way be related to geography would in no way suggest to one of ordinary skill in the art that a determination of a supercategory includes determining a geographic area that is a search term included in the user search query.

Applicants remind the Examiner that to establish a *prima facie* case of obviousness, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art, and not based on Applicants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1338

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(Fed. Cir. 1991). Applicants submit that any such teaching or suggestion is completely absent from Herz. Accordingly, the rejection of claim 12 is improper and should be withdrawn.

Claim 21 recites features similar to those recited in claim 12. Accordingly, for reasons similar to those given above for claim 12, the rejection of claim 21 should also be withdrawn.

In view of the foregoing amendments and remarks, Applicants respectfully request the Examiner's reconsideration of this application, and the timely allowance of the pending claims.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 07-2347 and please credit any excess fees to such deposit account.

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